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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,233	06/24/2003	Robert E. Sullivan	63134/P013US/10301974	1581
74243	7590	01/21/2009		
Slater & Matsil, L.L.P. 17950 Preston Road, Suite 1000 Dallas, TX 75252			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 01/21/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,233	Applicant(s) SULLIVAN ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/8/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 and 88-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 31-89 in the reply filed on October 8, 2008 is acknowledged. Claims 1-30 and 90-95 are withdrawn. The examiner notes that claims 88-89 depend from non-elected claim 1 and will also be considered withdrawn. Claims 31-87 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-62 are rejected under 35 U.S.C. 101.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard

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Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. System claims 31-62 recite a computer program (“engine”) that is not embodied in hardware. The claim is merely directed to computer software per se, see at least applicant’s specification paragraph 35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-56 and 58-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manto (US 2003/0076940 A1) and Hodge (US 2004/0029564 A1).

Referring to claim 31. Manto discloses a system for managing information with respect to a controlled environment facility comprising:

an information management engine having functionality for conducting transactions associated with residents of said controlled environment facility, said

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transactions including at least telephone calling service, wherein said information management engine provides integration with respect to said goods acquisition service and said telephone calling service providing communication outside of said controlled environment facility to facilitate acquisition of goods (Manto: abstract and figure 7).

Manto discloses all of the above including acquiring goods such as funds for completing phone calls but does not expressly disclose acquiring physical goods from a commissary. Hodge discloses a system for allowing family to manage a prison's accounts used for goods acquisition from a commissary and completing phone calls (Hodge: abstract figures 24-29 and paragraphs 7 and 52). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the system of Manto to have included allowing goods acquisition from a commissary, as taught by Hodge, in order to allow inmates and their families to transfer funds for phone calls or purchases from a commissary (Hodge: paragraph 6).

Referring to claims 32-35. The combination of Manto and Hodge further discloses a system wherein said facilitating acquisition of goods using said integration of said goods acquisition service and said telephone calling service comprises said information management engine invoking a contemporaneously outbound call to a person outside of said controlled environment facility when a resident of said controlled environment facility attempts to acquire goods in excess of an account value to allow for a deposit via a credit card transaction (Manto: figure 5 and paragraphs 52 and 62).

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Referring to claim 36. The combination of Manto and Hodge further discloses a system wherein said outbound call is utilized to acquire post paid billing authorization from said person outside of said controlled environment (figure 5).

Referring to claims 37-39. The combination of Manto and Hodge further discloses a system wherein said person outside of said controlled environment facility comprises a designated responsible party with respect to an account having said account value, designated by a user or by a person having previously deposited funds into said account (Manto: figure 5 and paragraph 8 disclosing sponsors for controlling accounts)

Referring to claim 40. The combination of Manto and Hodge further discloses a system wherein said facilitating acquisition of goods comprises setting a flag, when a resident of said controlled environment facility attempts to acquire goods in excess of an account value, for interacting with a person outside of said controlled environment when an outbound call is placed to said person (Manto: figure 5 and paragraph 62).

Referring to claim 41. The combination of Manto and Hodge further discloses a system wherein said outbound call is invoked by said resident and independent of said resident attempting to acquire goods (Manto: figure 7).

Referring to claims 42-43. The combination of Manto and Hodge further discloses a system wherein said interacting with said person interrupts said outbound call or is utilized to acquire funds from said person outside of said controlled environment for deposit to an account have said account value (Manto: figure 7).

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Referring to claims 44-45. Claims 44-45 are rejected under the same rationale set forth above in the rejection of claims 36-37.

Referring to claims 46-53. The combination of Manto and Hodge further discloses a system wherein said information management engine further has functionality for collecting and analyzing biometric data (voice print, finger print, iris print) to identify a user thereof in association with conducting said transactions and wherein identification of user is via biometric data and a PIN (figure 7, step 6 and paragraphs 83 and 148).

Referring to claim 54. The combination of Manto and Hodge further discloses a system having functionality for voice response interaction, thereby facilitating users thereof to conduct said transactions using voice commands (Manto: figure 5 and paragraph 55).

Referring to claims 55-56. The combination of Manto and Hodge further discloses a system wherein said goods acquisition service comprises a commissary or medical goods service (Manto: paragraph 33 and Hodge paragraph 6 as noted in the motivation to combine in the rejection of claim 31).

Referring to claims 58-60. The combination of Manto and Hodge further discloses a system providing for delivery of items (such as phone calls) to a resident or a person outside said controlled environment facility (Manto: figure 1 disclosing incoming calls and figure 2 disclosing outgoing phone calls).

Referring to claims 61-62. The combination of Manto and Hodge further discloses a system having functionality for gathering intelligence with respect to the

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velocity of transactions (Hodge: figure 12 disclosing monitoring the length of prisoner's phone call transactions). The motivation to combine Manto and Hodge would be the same as noted above in the rejection of claim 31.

Referring to claims 63-79. Method claims 63-79 are rejected under the same rationale set forth above in the rejection of system claims 31-56 and 58-62 containing similar limitations. The combination of Manto and Hodge further discloses methods for establishing purposes and limits with respect to prisoner's accounts (Hodge: paragraph 7) and flagging accounts that need replenishment (Manto: figure 5). The motivation to combine Manto and Hodge would be the same as noted above in the rejection of claim 31.

Referring to claims 80-87. Medium claims 80-87 are rejected under the same rationale set forth above in the rejection of system claims 31-56 and 58-62 containing similar limitations. The combination of Manto and Hodge further discloses mediums containing code for establishing purposes and limits with respect to prisoner's accounts (Hodge: paragraph 7) and flagging accounts that need replenishment (Manto: figure 5). The motivation to combine Manto and Hodge would be the same as noted above in the rejection of claim 31.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Manto and Hodge.

Referring to claim 57. The combination of Manto and Hodge discloses all of the above including a system for acquiring goods from a commissary or acquiring medical goods (see the rejection of claims 55-56). The combination of Manto and Hodge does not expressly disclose prisons acquire library goods. A predictable result of a system allowing prisons to acquire goods from a commissary or medical office would also be to allow prisons to acquire goods from the library. See KSR International Co. V. Teleflex Inc. et al., 82 USPQ2d 1385 (U.S. 2007).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Anders, Gainsboro, Findley, Mow, Gerdes, Bayne, Kurth, and Mudd disclose systems and methods for managing prisoner accounts and telephone calls.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/
1/16/09